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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/375,239 08/16/99 MUSSO

E P8910-9024

EXAMINER

IM22/0705

Arent Fox Kintner Plotkin & Kahn
1050 Connecticut Avenue, N.W., Suite 600
Washington DC 20036-5339

SERGEANT, R

ART UNIT

PAPER NUMBER

1711

DATE MAILED:

07/05/00

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
09/375,239

Applicant(s)
Musso et al.

Examiner
Rabon Sergeant

Group Art Unit
1711



☒ Responsive to communication(s) filed on Mar 29, 2000

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-8, 10-18, 22, and 23 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-8, 10-18, 22, and 23 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☒ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☒ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been

☒ received.

☐ received in Application No. (Series Code/Serial Number) _____

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 5,6

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 15 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. A "use" is not a statutory class of invention.
3. Claim 15 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

If applicants intend that the subject matter of claim 15 be drawn to a process, then it should be so claimed, and a definitive process step must be claimed.

4. Claim 3 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

It is unclear what limitations are set forth by the subject matter of claim 3. Applicants' amendment has not clarified the language.

5. Claim 11 is rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable one skilled in the art to, which it pertains, or with which it is most nearly connected, to make and/or use the invention.

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Applicants have failed to provide adequate enablement with respect to the hydrofluoropolyethers which may be incorporated within the foaming composition.

6. Claims 4-7 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicants have not provided support for the amended language of claims 4-7. The 40 parts by weight language is not equivalent to the 40 or 50 percent language of the previous claims. Furthermore, it is unclear from the language that one component replaces part of another.

7. Claims 4-8, 10, 11, and 14-16 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Since applicants have amended claim 1 to use "consisting essentially of" for the foaming agent, the position is taken that the foaming agent compositions are closed to the inclusion of components that will materially affect the composition. Therefore, the inclusion of additional blowing agent components not provided for by the compositions of claim 1 is improper. This position applies to the ternary compositions of claims 4-8, 10, and 11 and the water or carbon dioxide compositions of claims 14-16.

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8. Claims 12-16, 18, 22, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The claims are improperly dependent from two claims.

9. Claim 23 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The subject matter of claim 23 is unclear, because it specifies that polymers are selected from foaming compositions.

10. Claims 1-8, 10-18, 22, and 23 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Throughout the claims, applicants have used the wrong structural formula in connection with the recited compound name.

Furthermore, within claims 5 and 7, applicants have specified that the same compound is added to itself.

11. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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12. Claims 1-3, 12, 13, 18, 22, and 23 are rejected under 35 U.S.C. 102(b) as being anticipated by Klug et al. ('882 or '016 or '931).

Patentees disclose azeotropic compositions and their use as blowing agents for polyurethanes and polyolefins wherein compositions which correspond to applicants' compositions; IV, V, D, and E; are disclosed. See abstracts. Since azeotropic compositions are disclosed, applicants' percent compositions are considered to be inherently met by the references.

13. Applicants have argued that Klug et al. do not disclose that the compositions possess the same properties as CFC-11 foaming agent. Applicants' argument is totally without merit. Firstly, applicants' claims are not limited in accordance with the argument. Secondly, patentees' compositions are disclosed as being azeotropic; therefore, they comprise the same components in the same amounts as applicants' azeotropic compositions and, consequently, will inherently function as blowing agents to the same extent as applicants' compositions.

14. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37

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CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication should be directed to R. Sergent at telephone number (703) 308-2982.

R. Sergent/ns

July 1, 2000


**RABON SERGENT
PRIMARY EXAMINER**